

#3

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

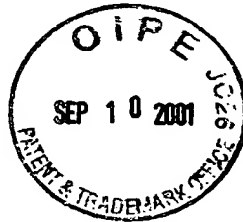
In re Patent Application of

Randolph J. Noelle et al.

Application No.: 09/849,969

Filed: May 8, 2001

For: Method to Treat Multiple Sclerosis  
with Gp39-Specific Antibodies



**RESPONSE TO NOTICE TO FILE MISSING PARTS  
OF NONPROVISIONAL APPLICATION**

Assistant Commissioner for Patents  
Washington, DC 20231

Sir:

In response to the Notice to File Missing Parts of Nonprovisional Application mailed July 10, 2001, requiring Applicants to provide a signed Declaration from inventor Randolph J. Noelle and to pay the late declaration surcharge of \$130.00 to avoid abandonment of the application, Applicants respectfully submit that it is believed that the Notice was sent erroneously. Applicants further submit that it is believed that the requirements under 37 CFR 1.53(b) were met at the time of filing of the continuation application based on the following information:

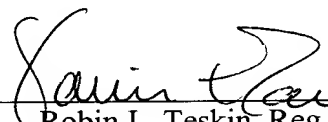
On May 8, 2001, Applicants filed the subject application as a continuation application of U.S. Application No. 09/080,349 (the "parent application"), which is a continuation of U.S. Application No. 08/481,735 (the "grandparent application"). At the time of filing, Applicants' counsel submitted a copy of the parent application, including claims and abstract; a continuation transmittal form; a copy of the Declaration and Power of Attorney executed by Eric Claassen from the grandparent application; a copy of the Declaration and Power of Attorney executed by Randolph J. Noelle in the grandparent application; a preliminary amendment; and a post card itemizing Applicants' submission.

Applicants believe that because the inventors executed two separate copies of the Declaration, the U.S. Patent Office may have inadvertently overlooked the signed copy of the Declaration of Randolph J. Noelle, which was attached directly behind the signed Declaration of Eric Claassen and filed at the time the subject continuation application was filed. Because no changes to the claims of the parent application have been made to date, Applicants believe that they are not obligated to submit a Supplemental Declaration and that the Declarations filed with the continuation application should fulfill the requirements of 37 CFR 1.53(b). As evidence thereof, Applicants provide copies of the Declarations and Powers of Attorneys executed by inventors Noelle and Claassen as Exhibit A, and a copy of the date-stamped post card acknowledging receipt of the above-identified parts of the application as Exhibit B.

Based on the foregoing, Applicants respectfully request that the Notice to File Missing Parts of Nonprovisional Application be withdrawn and that the application be deemed to fulfill the requirements of §1.53(b) and therefore, be forwarded to the appropriate Group Art Unit for examination. Because Applicants met the requirements of §1.53(b) at the time of filing, no late filing declaration surcharge is believed to be required.

It is respectfully requested that the undersigned representative be contacted in the event there are questions regarding the foregoing information.

Respectfully submitted,

By:   
Robin L. Teskin, Reg. No. 35,030  
Samir Elamrani, Reg. No. 43,601

1600 Tysons Boulevard  
McLean, VA 22102  
(703) 905-2000  
(703) 905-2500 F

Date: September 10, 2001

# EXHIBIT A



# EXHIBIT B



Applicant: Randolph J. Noelle et al.  
Serial No. (Unassigned)  
Title: *Method to Treat Multiple Sclerosis with Gp39-Specific Antibodies*

RXT  
5/8/01  
037003  
0280613

THE FOLLOWING WAS FILED IN THE U.S. PATENT & TRADEMARK OFFICE:

- ☒ New CONTINUATION Application containing:
  - ☒ Specification - 14 pp.
  - ☒ Claims - 11 total/2 independent
  - ☒ Drawings - 4 sheets
  - ☒ Abstract of the Disclosure
- ☒ New Continuation Transmittal Form
- ☒ Declaration and Power of Attorney (as Filed in Parent Application)
- ☒ Preliminary Amendment
- ☒ Authorization to Charge Deposit Account for \$710.00
- ☐ OTHER: \_\_\_\_\_



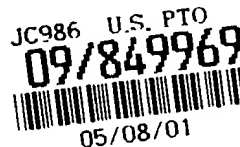
CURRENT DUE DATE: \_\_\_\_\_

Applicant: Randolph J. Noelle et al.  
Serial No. (Unassigned)  
Title: *Method to Treat Multiple Sclerosis with Gp39-Specific Antibodies*

RXT  
5/8/01  
037003  
0280613

THE FOLLOWING WAS FILED IN THE U.S. PATENT & TRADEMARK OFFICE:

- ☒ New CONTINUATION Application containing:
  - ☒ Specification - 14 pp.
  - ☒ Claims - 11 total/2 independent
  - ☒ Drawings - 4 sheets
  - ☒ Abstract of the Disclosure
- ☒ New Continuation Transmittal Form
- ☒ Declaration and Power of Attorney (as Filed in Parent Application)
- ☒ Preliminary Amendment
- ☒ Authorization to Charge Deposit Account for \$710.00
- ☐ OTHER: \_\_\_\_\_



CURRENT DUE DATE: \_\_\_\_\_

Sector



## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

## FILING COMPLETION UNDER RULE 53(f)

( NOT PCT Applications)  
For Design, Provisional, or Utility Applications

PATENT  
APPLICATION

**COMPLETION Under**  
**Rule 53(f)**

In re PATENT APPLICATION of  
Inventor(s): Randolph J. Noelle et al.  
Appln. No.: 09 | 849,969  
Series Code  $\uparrow$  | Serial No.  $\uparrow$

Attn: Application Division

Atty.Dkt. P | 0280613 | 1995-300232C2  
M# | Client Ref

Filed: May 8, 2001  
Title: Method to Treat Multiple Sclerosis with Gp39-Specific Antibodies

Hon. Commissioner of Patents  
Washington, DC 20231

Date: September 10, 2001

Sir:

The following **completes the filing** under Rule 53(f) of the above-identified patent application:

1. **Notice to File Missing Parts** ☒ copy attached ☐ not yet received  
2. ☒ Signed Declaration attached. ☐ Original ☒ Facsimile/Copy

(Always "X" box 2 if filing signed Declaration and

"X" box 2A only if top box of the Declaration is X'd and file application copy, or

"X" box 2B only if none of the top three boxes of the Declaration is X'd.)

- 2A. ☐ Attached: Original signed Declaration with attached specification (including claim(s)) which is a copy of specification and claim(s) originally filed to secure the above filing date.  
2B. ☒ The original application as filed in the PTO on the above filing date is the application which each inventor executed by signing the attached Rule 63 Declaration.  
3. ☐ Specification originally filed in non-English language; hence verified translation attached of:  
a. ☐ Abstract  
b. #        pages of Specification (only spec. & claims)  
c. ☐ Drawing(s)                      No of Sheets  
☐ Fig(s).                       
4. ☐ Letter filing formal drawing attached.  
5. ☐ Attached is an assignment and cover sheet. Please return the recorded assignment to the undersigned.  
6. **DOMESTIC/INTERNATIONAL** priority is claimed under 35 USC 119(e)/120/365(c) based on the following provisional, nonprovisional and/or PCT international application(s):

Application No.	Filing Date	Application No.	Filing Date
(1) 09/080,349	5/18/98	(2) 08/481,735	6/07/95
(3)		(4)	
(5)		(6)	

7. **FOREIGN** priority is claimed under 35 USC 119(a)-(d)/365(b) based on filing in                       
8.

Application No.	Filing Date	Application No.	Filing Date
(1)		(2)	
(3)		(4)	
(5)		(6)	

Completion Under Rule 53(f)

9. \_\_\_\_\_ (No.) Certified copy (copies): ☐ attached; ☐ previously filed (date) \_\_\_\_\_  
in U.S. Application No. \_\_\_\_\_ / \_\_\_\_\_ filed on \_\_\_\_\_
10. Small Entity Status ☐ ☒ is Not claimed ☐ is claimed (file PAT-256 if this is the first claim of Small Entity Status)
11. ☒ Attached: Response to Notice to File Missing Parts of Nonprovisional Application, Exhibit A -- Copy of Executed Declaration by Randolph J. Noelle and Eric Claassen, Exhibit B -- Copy of postcard date stamped by USPTO acknowledging receipt of same
12. ☐ Preliminary Amendment:

**THE FOLLOWING FILING FEE IS BASED ON CLAIMS AS FILED LESS ANY ABOVE CANCELLED**

		Large/Small Entity		Fee Code
13. Basic Filing Fee . . . . . Design Application		\$320/\$160		106/26
Not Design Application		\$710/\$355	+	101/201
14. Total Effective Claims	minus 20 =	x \$18/\$9	+0	103/203
15. Independent Claims	minus 3 =	x \$80/\$40	+0	102/202
16. If any proper multiple dependent claim (ignore improper) is present, (Leave this line blank if this is a reissue application)		\$270/\$135	+0	104/204
17. Surcharge for filing Declaration/filing fee late		\$130/\$65	+0	105/205
18. FILING FEE ENCLOSED =		\$		
19. Original due date: September 10, 2001				
20. Petition is hereby made to extend the original due date to cover the date this response is filed for which the requisite fee is attached		(1 mo) \$110/\$55 = (2mos) \$390/\$195 = (3mos) \$890/\$445 = (4mos) \$1390/\$695 =	+0	115/215 116/216 117/217 118/218
21. If "non-English" box 3 is X'd, add Rule 17(k) processing fee . . . . .		\$130	+0	139
22. If "assignment" box 5 is X'd, add recording fee. . . . .		\$40	+0	581
23. Petition Fee for		\$130	+0	
24. TOTAL FEE ENCLOSED =		\$	-0-	

Our Deposit Account No. 03-3975

Our Order No. 037003

0280613

C#

M#

**CHARGE STATEMENT:** The Commissioner is hereby authorized to charge any fee specifically authorized hereafter, or any missing or insufficient fee(s) filed, or asserted to be filed, or which should have been filed herewith or concerning any paper filed hereafter, and which may be required under Rules 16-18 (missing or insufficiencies only) now or hereafter relative to this application and the resulting Official document under Rule 20, or credit any overpayment, to our Account/Order Nos. shown in the heading hereof for which purpose a duplicate copy of this sheet is attached. This CHARGE STATEMENT does not authorize charge of the issue fee until/unless an issue fee transmittal form is filed.

**Pillsbury Winthrop LLP**  
**Intellectual Property Group**

1600 Tysons Boulevard

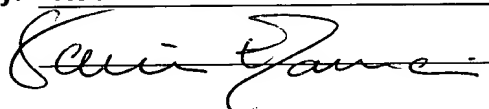
By Atty: Robin L. Teskin/Samir Elamrani Reg. No. 35,030/43,601

McLean, VA 22102

Tel: (703) 905-2000

Atty/Sec: RLT/SXE/lak

Sig:



Fax: (703) 905-2500

Tel: (703) 905-2200

**NOTE: File in duplicate with PTO receipt (PAT-103A) and attachments**



## UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS  
UNITED STATES PATENT AND TRADEMARK OFFICE  
WASHINGTON, D.C. 20231  
www.uspto.gov

APPLICATION NUMBER	FILING/RECEIPT DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NUMBER
09/849,969	05/08/2001	Randolph J. Noelle	P 0280613 1995-300232C2

Intellectual Property Group  
of Pillsbury Winthrop LLP  
Ninth Floor, East Tower  
1100 New York Avenue, N.W.  
Washington, DC 20005-3918



CONFIRMATION NO. 1327

## FORMALITIES LETTER



\*OC000000006276873\*

Date Mailed: 07/10/2001

## NOTICE TO FILE MISSING PARTS OF NONPROVISIONAL APPLICATION

FILED UNDER 37 CFR 1.53(b)

*Filing Date Granted*

An application number and filing date have been accorded to this application. The item(s) indicated below, however, are missing. Applicant is given **TWO MONTHS** from the date of this Notice within which to file all required items and pay any fees required below to avoid abandonment. Extensions of time may be obtained by filing a petition accompanied by the extension fee under the provisions of 37 CFR 1.136(a).

- The signature of the following inventor(s) is missing from the oath or declaration:  
*Randolph J. Noelle*
- To avoid abandonment, a late filing fee or oath or declaration surcharge as set forth in 37 CFR 1.16(e) of \$130 for a non-small entity, must be submitted with the missing items identified in this letter.
- The balance due by applicant is \$ 130.

*A copy of this notice **MUST** be returned with the reply.*

AM

Customer Service Center

Initial Patent Examination Division (703) 308-1202

PART 2 - COPY TO BE RETURNED WITH RESPONSE